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7/20/07

In re Application of:
SOLAR, MATTHEW S. et al.
Serial No.: 10/671,913
Filed: Sep. 25, 2003
Docket: 723.061US1
Title: BALL AND SOCKET TRAJECTORY
GUIDE

DECISION ON PETITION

This is a decision on the petition filed on Jan. 5, 2007 by which petitioner requests reconsideration and withdrawal of the restriction requirement mailed Aug. 8, 2006, and that non-elected claims 8, 10, 13, 24, 26-28 and 30-34 be rejoined and examined on the merits. Claims 1-3, 5, 6, 9, 11, 12, 14-23 and 25 were elected for prosecution. This petition is considered as if pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is **DISMISSED**.

A review of the record reveals that a restriction requirement was made between two disclosed and claimed related inventions: I) an alignment device and II) a method of manufacturing an alignment device. Claims 1-3, 5, 6, 8-20 and 22-25 are drawn to the alignment device, and claims 26-28 and 30-34 are drawn to the method of manufacturing the alignment device.

In judging the propriety of the restriction requirement, the related inventions, as claimed, must be shown to be distinct. See MPEP 802.01. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process as claimed can be used to make another and materially different product or (2) the product as claimed can be made by another and materially different process. See MPEP 806.05(f).

In the instant application, the distinctness between the claimed inventions was justified in that the product as claimed can be made by another and materially different process, such as blow molding or extrusion.

Petitioner traverses the rationale set forth above by basically arguing that the method claims necessarily requires a "forming" limitation. In the petition, petitioner states 'There is no objective evidence anywhere in the present specification that the term "forming" was intended to exclude "blow molding" or "extrusion" or any other particular process of "forming"'. Petitioner

is essentially saying that because the method claims have “forming” steps, the forming steps would encompass “blow molding” or “extrusion” when making the product as claimed. Therefore, there would be no distinction between the method of making claims and the product claims.

However, such traversal is not persuasive because not all of the manufacturing steps in the method claims require “forming” steps. Method claim 26 positively recites the limitation “*attaching* a spherical portion to an end of the longitudinal guide portion” [emphasis added]. Attaching clearly does not encompass blow molding or extrusion. Therefore, the spherical portion could be made unitarily with the longitudinal guide portion by blow molding or extruding together instead of using an assembly operation such as attaching the spherical portion to the end of the longitudinal guide portion.

Furthermore, as part of any restriction requirement, the search and examination for each of these two claimed inventions must be considered a serious burden on the examiner if restriction were not required. See MPEP 803 and 808.02. Aside from the different classifications indicated in the requirement, the search for the process claims would involve a search in areas such as where assembling methods are found, for example in class 29, etc., which are diverse from the search for the product claims.

In addition to the above restriction requirement, the examiner also required an election of species between the embodiments represented by Figures 1A-4. The requirement translates alleged species I depicted by Figures 1A-1C, species II depicted by Figure 2, species III depicted by Figures 3A-3C, species IV depicted by Figure 4, and species V depicted by Figure 5.

Petitioner’s position is that the election of species requirement fails to give any reasons or examples of what renders the asserted species I-V patentably distinct. In addition, petitioner states that the requirement fails to show a serious burden by appropriate explanation of a separate classification, or separate status in the art, or a different field of search. Respectfully, these points are not well taken in that the examiner has indicated how each of the species is patentably distinct on pages 2-3 of the restriction requirement. In addition, requirements for restriction between distinct inventions (related as disclosed) are described in MPEP 806.05-806.05(j) and necessarily require a showing of separate classification, separate status in the art, or a different field of search. MPEP 808.01(a) proscribes the definition of species as “Where there is no disclosure of relationship between species (MPEP 806.04(b)), they are independent inventions and election to one invention following a requirement for restriction is mandatory even though applicant disagrees with the examiner.” There must be a patentable difference between the species as claimed. See MPEP 806.04(h). Since the claims are directed to independent inventions, restriction is proper pursuant to 35 USC 121 and it is *not necessary to show a separate status in the art or separate classification* [emphasis added]. Therefore, arguments to the procedural failure of an election of species requirement for not explaining the relation between inventions or providing an allegation of serious burden are not persuasive here.

Applicant’s argument that claim 1 is a generic claim because the examiner has not provided any objective explanation for why the language of claim 1 is not generic is noted. However, in view of the amendment to the claims in the response filed May 29, 2007, all of the pending

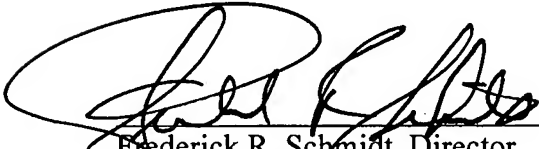
independent claims now require a "shelf" as shown in the elected species depicted in Figure 3C. Therefore, claim 1 nor any of the other pending independent claims are generic because "shelf" was added to these claims.

Conclusion

For the reasons outlined above, the restriction requirement promulgated in the restriction requirement dated Aug. 8, 2006 is in accordance with proper Office procedure. Accordingly, the Office action stands. Therefore, the examiner's restriction requirement is proper.

The application is being forwarded to Supervisory Patent Examiner of Art Unit 3731 for further processing. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Marc Jimenez, Training Quality Assurance Specialist, at (571) 272-4530.

The petition is DISMISSED.



Frederick R. Schmidt, Director
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